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In the Supreme Court of the United States

OCTOBER TERM, 1968

MIKE ROBERTS COLOR PRODUCTIONS, INC.,
Petitioner

vs.

COLOURPICTURE PUBLISHERS, INC.,
Respondent

Petition for a Writ of Certiorari to the United States Court of Appeals for the First Circuit

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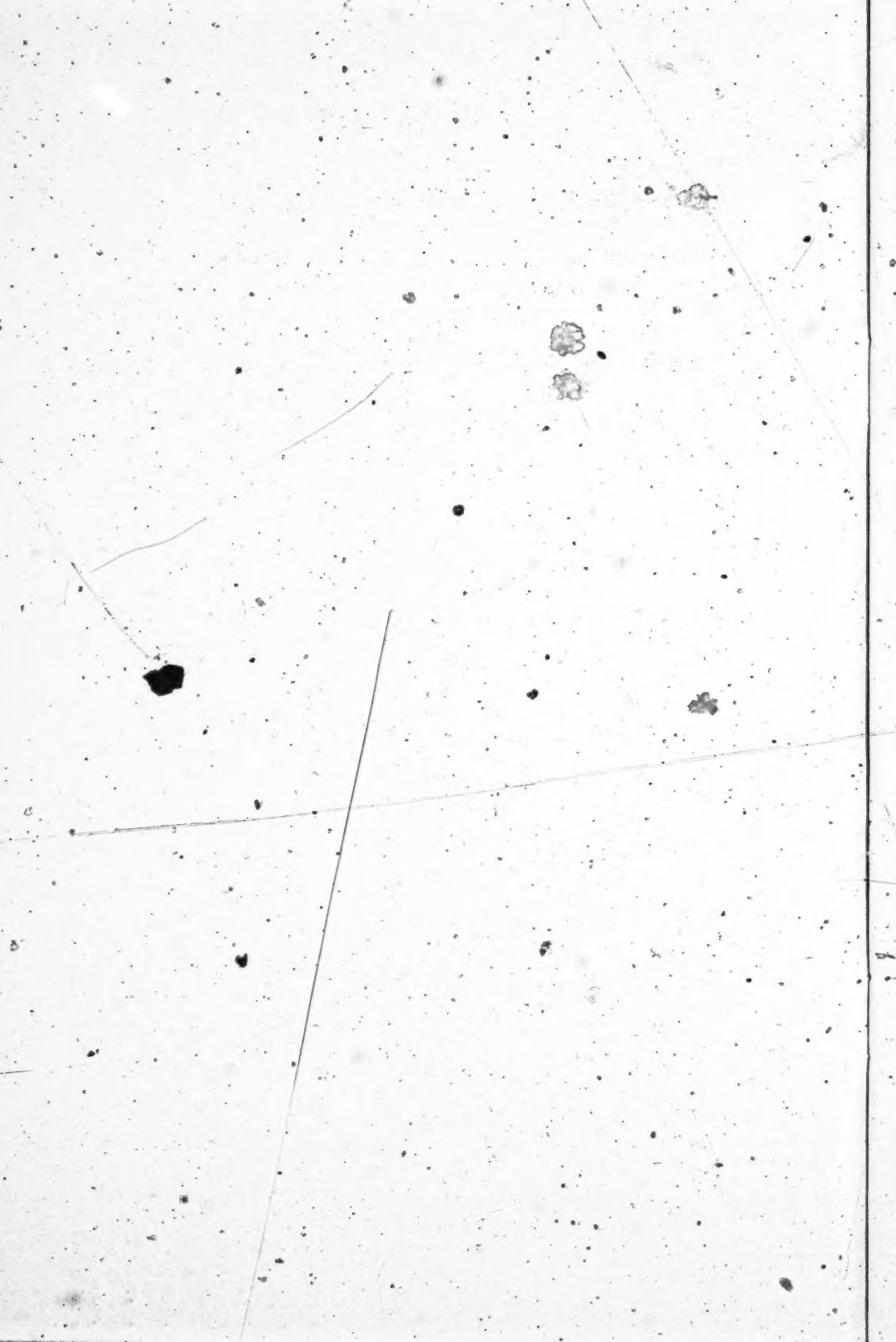

SUBJECT INDEX

	Page
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutory Provisions Involved	2
Statement of the Case	3
Subject Matter of the Tichnor Patent	3
The State of the Prior Art	4
The Novelty (If Any) of the Tichnor Patent	8
The Summary Judgment of the District Court	8
The Reversal by the Court of Appeals	10
Reasons Why the Writ Should Be Granted	11
Conclusion	16
Appendices	
Opinion of the Court of Appeals	1a
Judgment of the Court of Appeals	8a
Opinion of the District Court	9a
Publicity Concerning the Court of Appeals Decision Promulgated by Respondent	14a

TABLE OF AUTHORITIES CITED

Cases	Pages
Alladin Plastics, Inc. v. Jerrold Stephan Co., 362 F.2d 532 (9th Cir. 1966)	15
Allen-Bradley Co. v. Air Reduction Co., 391 F.2d 282 (3rd Cir. 1968)	16
Graham v. John Deere, 383 U.S. 1	2, 12, 13, 14, 15, 16
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 156 (1950)	12, 13
Monoplastics, Inc. v. Caldor, Inc., 378 F.2d 20 (2nd Cir. 1967)	15
Walker v. General Motors, 362 F.2d 56, (9th Cir. 1966)	11, 15, 16

Statutes	
Federal Rules of Civil Procedure, Rule 56	2, 3, 8, 12, 13, 14, 15
28 U.S.C.:	
§ 1254(1)	2
§ 1338(a)	2
35 U.S.C.:	
§ 101 and 102	11
§ 102(b)	8
§ 103	2, 9, 11, 12

Texts	
Moore, Federal Practice, 2nd Ed. Vol. 6, pp. 2057, 2613-2617	13
Mayer, "The Lawyers", pp. 400-401	13

In the Supreme Court of the United States

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MIKE ROBERTS COLOR PRODUCTIONS, INC.,
Petitioner

vs.

COLOURPICTURE PUBLISHERS, INC.,
Respondent

Petition for a Writ of Certiorari to the United States Court of Appeals for the First Circuit

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Petitioner, Mike Roberts Color Productions, Inc., prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit in the above-entitled case.

OPINIONS BELOW

The opinion of the Court of Appeals is reported at 394 F2d 431; 157 USPQ 659, and is reprinted in Appendix I, p. 1a, *infra*. The opinion of the District Court for the District of Massachusetts is reported at 272 F. Supp. 280, and is reprinted in Appendix III, p. 9a, *infra*.

JURISDICTION

The judgment of the Court of Appeals was made and entered on May 8, 1968 (Appendix II, p. 8a, *infra.*) The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1). The basis of jurisdiction in the District Court was 28 U.S.C. § 1338(a).

QUESTIONS PRESENTED

1. Did this Court, in *Graham v. John Deere,* 383 U.S. 1, intend to hold that "the hazards"[1] of Rule 56 (summary judgment) of the Federal Rules of Civil Procedure are increased and that, in addition to the general requirements of Rule 56, "specific inquiries [are] exacted"[1] in any patent case where the question of obviousness is the issue?

2. Is the traditional function of Rule 56 in terminating litigation at any early stage abrogated by *Graham* in Section 103[2] patent cases, even where the patented device is very simple and easily understood and where the defense of obviousness is based upon the admitted state of the prior art, if the patentee alleges unobviousness and says that he will bring witnesses into court to testify to that effect?

3. Is it the intended result of *Graham* to require District Courts to refrain from rectifying clear error by the Patent Office in applying the Constitutional standard of invention until there has been a trial of the issue of obviousness?

STATUTORY PROVISIONS INVOLVED

One statute (35 U.S.C. 103) and one rule (Rule 56 (c), Federal Rules of Civil Procedure) are involved. These read as follows:

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1. The quoted matter is from the opinion of the Court of Appeals, 394 F2d at 435, 157 USPQ at 662, Appendix I at 7a.

2. 35 U.S.C. 103.

35 U.S.C. 103: "A patent may not be obtained though the invention is not identifically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Rule 56(c): "The motion [for summary judgment] shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages."

STATEMENT OF THE CASE

This is a patent suit brought by Respondent against Petitioner for infringement of Tichnor U.S. Patent No. 3,259,304 (hereinafter referred to as Tichnor patent) entitled "Postcards".

Subject Matter of the Tichnor Patent

The Tichnor patent, aptly described by the Court of Appeals as one of "provokingly irresistible simplicity", is for a strip or sheet of several picture postcards arranged for simultaneous display of the pictures and having a top

card or panel with a hole in it so that it can be suspended from a hook for display. This top card or panel may have advertising printed on it.

This simple structure is reproduced from the drawings of the Tichnor patent on page 5 of this Petition. See also Record Appendix to Brief for Appellant, page 35. (This part of the record will be referred to as Record Appendix.) Figure 1 illustrates the front or pictorial side of the strip or sheet and Figure 2 illustrates the back or message side of the strip or sheet. The panel 15 at the top is formed with a hole 17 for suspending the sheet or strip of cards from a hook. Pl's Exhibit 2 (a physical exhibit) is a specimen of Respondent's (the patentee's) actual product sold under the Tichnor patent. A specimen of Petitioner's sheet or strip of picture postcards which is alleged to infringe the Tichnor patent is reproduced in Record Appendix at page 81 (front side) and 82 (back side). Pages 81 and 82 of the Record Appendix, although marked thereon as "Exhibit C", are actually parts of Pl's Exh. 6, Request for Admissions, Record Appendix 75.

The State of the Prior Art

The Tichnor patent itself sets forth certain pertinent background and prior art. At column 1, commencing at line 15, the patent says

> "Such [picture post] cards are often produced by lithographing or otherwise reproducing scenic or other graphic illustrations on one side of a large sheet and printing informational material on the rear side. The sheet is then divided as by cutting at the factory to form individual cards." (Matter in brackets added)

This is to say, the Tichnor patent acknowledges that it is old to manufacture picture postcards in sheets with the

July 5, 1966 L. F. TICHNOR 3,259,304

POSTCARDS

Filed May 25, 1965

FIG. 1

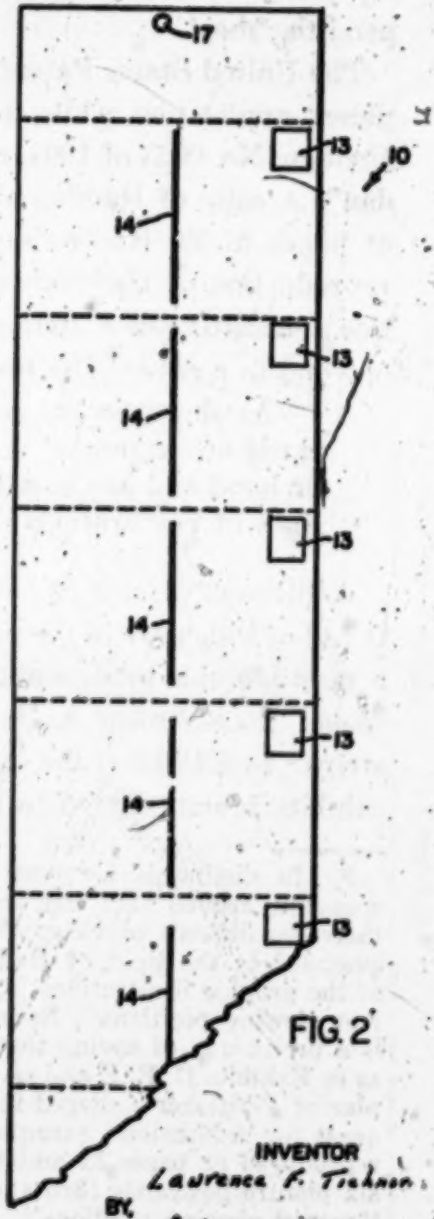


FIG. 2

INVENTOR
Laurence F. Tichnor

BY
Wolf, Greenfield & Hutz

ATTORNEYS

pictures on one side and informational material on the other side. What the Tichnor patent adds to these old sheets is a top panel with advertising material and with a hole to suspend the sheet.

The United States Patent Office cited against the Tichnor patent application, while it was pending, a British patent, Haddan, No. 9023 of 1904, referred to hereinafter as "Haddan". A copy of Haddan appears in the Record Appendix at pages 57-59. Haddan's structure is an album (see the reproduction of Haddan's drawing on page 7 of this Petition) consisting of a strip of picture postcards attached at one end to a cover. The text of Haddan at lines 10-12 says

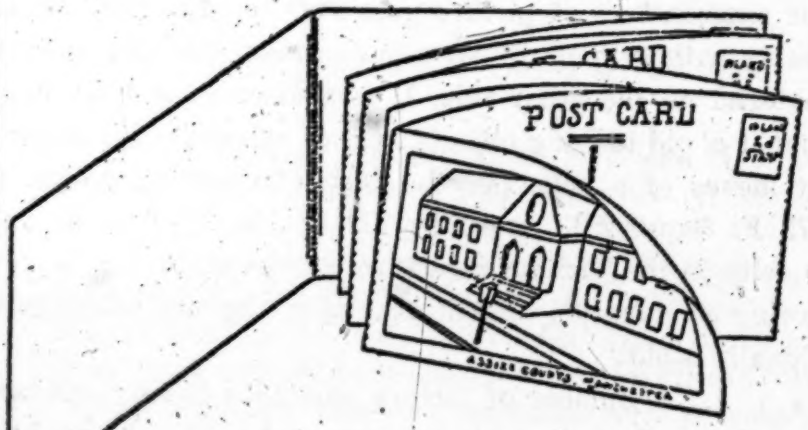
> "As shown in the annexed drawing a series of postcards are arranged in the form of a continuous strip or band and are merely separated from each other by lines of perforations."

Additionally, each of Defendants' Exhibits D, E, F and G (all of which are in the record as physical exhibits) shows a multiple side-by-side arrangement (rather than an end-to-end arrangement as in Haddan) of picture cards in strips.[3] In Exhibit G the cards are picture postcards. These exhibits are stipulated to be samples of devices on sale in

---

3. In distinguishing from Haddan in the Patent Office, Respondent argued that the postcards of Haddan are end-to-end, therefore difficult to view, whereas the claims of Respondent, as amended in the light of Haddan, specify that "substantially all of the graphic illustrations [are] presented to the eye in their correct viewing positions". Record Appendix pages 44 and 46. This is a prolix way of saying that the cards are arranged side-by-side, as in Exhibits D, E, F and G. Note also that in Respondent's exemplar of Petitioner's alleged infringement, Pl's Exhibit No. 6 (Request for Admissions, exemplar marked therein as Exhibit C and reproduced at pages 81 and 82 of Record Appendix), two of the six picture postcards (3rd and 4th from the top) are not in their "correct viewing positions".

A.D. 1901. APRIL 19. N° 9023.
HADDAN'S COMPLETE SPECIFICATION. (1 SHEET)



[This Drawing is a reproduction of the Original on a reduced scale]

this country more than one year prior to the filing date of the Tichnor patent.[4] See Record Appendix at page 87.

The Novelty (If Any) of the Tichnor Patent

Postcards *per se* are old, including picture postcards with pictures on one side and printed matter for a message, address, etc., on the reverse side. The assembly of such cards in strips or sheets is old, being shown in Haddan and in Exhibits D, E, F and G. Also, as acknowledged by Tichnor patent (page 4, *supra*) it is conventional during the manufacture of picture postcards to produce them as sheets with graphic illustrations on one side and printed material on the other side. It is also common knowledge that it is old to hang objects such as calendars for display by means of a hole. See the District Court's Opinion at 272 F. Supp. 281, Appendix III at 10a. If there is any novelty in the Tichnor structure it must reside in the following combination of features, each of which taken individually is old:

1. A number of picture postcards having substantially all of the pictures presented to the eye in their correct viewing position.

2. Such postcards being connected together in a strip or sheet but separable from one another.

3. A top panel at one end for the display of advertising material, such top panel having a hole in it for hanging the strip or sheet.

The Summary Judgment of the District Court

Petitioner filed and served a motion for summary judgment under Rule 56, Federal Rules of Civil Procedure. The

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4. The applicable statute, 35 USC 102(b), renders unpatentable an invention that was "on sale in this country, more than one year prior to the date of application for patent in the United States . . ."

basis of this motion was that the Tichnor structure does not comply with 35 USC 103, which reads as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

The District Court granted the motion on the following grounds:

> "On the basis of Exhibits D, E, F, G and H, I rule that the '304 patent is invalid under the provisions of 35 U.S.C.A. § 103 for lack of invention over the prior art. Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). An examination of plaintiff's alleged invention (Pl. Ex. 2) shows that it consists of nothing more than a glossy cardboard strip divided into six colored postcards, each detachable from the remainder at its perforated edges, together with a short additional strip utilized for the purpose of hanging it on a wall through the medium of an ordinary round hole punched therein. There is no invention in using a punched hole to hang a piece of paper on a wall. The Court will judicially notice that calendars have been affixed to walls for a great many years through the medium of a punched hole in the top portion thereof. There is likewise no invention in having space for advertising material at the top or elsewhere on the strip, since it is a matter of common knowledge susceptible of judicial notice that innumerable calendars, and other cardboard display pieces suitable for wall hanging, such as high and low tide tables, local fire alarm listings, and athletic team

schedules, to name but a few, have had advertising material imprinted on them for a great many years. No expert testimony is necessary to compare the various exhibits before the Court on this motion and to determine the lack of invention, within the meaning of 35 U.S.C.A. § 103, on the basis of which defendant's motion for summary judgment must be granted. George P. Converse & Co. v. Polaroid Corp., 242 F.2d 116, 120 (1st Cir. 1957); Glagovsky v. Bowcraft Trimming Co., 267 F.2d 479 (1st Cir. 1959)." (272 F. Supp. 281); Appendix III at 10a, 11a.

The Reversal by the Court of Appeals

The Court of Appeals characterized the patented structure as one of "provokingly irresistible simplicity". 394 F.2d at 432; 157 USPQ at 660, Appendix I at 2a. The Court of Appeals held, nevertheless, that summary judgment was inappropriate because several advantages were asserted (low cost of manufacture, economic and effective display and servicing by retailers, instant appraisal by the customers); because considerable commercial success was alleged; and because 37 distributors of postcards had in identical affidavits, acknowledged novelty, utility and unobviousness of the invention. See Court of Appeals opinion at 394 F.2d 433, 157 U.S.P.Q. at 660, Appendix I at 2a, 3a.

The Court of Appeals at 394 F.2d 434, 157 USPQ at 662, Appendix I at 5a deemed it

> ". . . not impossible that Colourpicture [Respondent], if allowed to proffer postcard manufacturers and distributors as witnesses, might establish that the simple ideas in the Tichnor patent were not obvious to practitioners in that occupation." (Matter in brackets added)

and that

> "[i]t might also be relevant, in determining obviousness, to see whether and, if so, how the problem met by Tichnor's patent had been treated by others."

In conclusion the Court of Appeals said:

> "Nor is this to say that even the issue of obviousness could not in a proper case be decided by summary judgment. See *Walker v. Gen. Motors Corp.*, 362 F. 2nd 56 (9th Cir. 1966). But we do say that where obviousness is the issue, *Graham* increased the hazards of this route to decision.
>
> "In addition to the stringent requirements governing summary judgment generally and the specific inquiries exacted by *Graham*, the presumptive validity given to patent claims under 35 USC § 282 is also pertinent. We conclude that the district court erred in granting summary judgment under Section 103, noting, however, that nothing we have said here should be interpreted as indicative of the ultimate validity or invalidity of the Tichnor patent." 394 F.2d at 435; 157 U.S.P.Q. at 662; Appendix I at 6a, 7a.

REASONS WHY THE WRIT SHOULD BE GRANTED

1. The decision of the Court of Appeals makes it impossible to obtain summary judgment in a patent suit where the issue is obviousness under 35 USC 103.

The Court of Appeals at 394 F.2d 435, 157 USPQ 662, Appendix I, 6a, concedes that ". . . even the issue of obviousness could—in a proper case be decided by summary judgment," citing *Walker v. General Motors*, 362 F.2d 56, (9th Cir. 1966). Nevertheless, no patent could be simpler than the Tichnor patent and if the prior art were any closer than it is, there would be complete anticipation under 35 USC 101 and 102.[5] Under the rule stated by the Court of Appeals in this case all that any patentee need do to avoid summary judgment on the ground of obviousness under Section 103 is to allege that his invention was

5. 35 U.S.C. 101 requires that the invention be "new" and 35 USC 102 also requires novelty.

not obvious and to obtain *ex parte* statements of several persons to that effect. If the case at bar is not "a proper case" for summary judgment on the ground of obviousness, then there can be no such case.

2. Rule 56 should serve as a check on the propensity of the Patent Office to issue patents without applying the standards set forth in *Graham v. John Deere,* 383 U.S. 1 (1966).

In *Graham,* at 383 U.S. 18, this Court said that it is the primary responsibility of the Patent Office to sift out unpatentable material; that to await litigation is for all practical purposes to debilitate the patent system; and that there is a "notorious difference" between the standards of invention applied by the Patent Office and by the courts. This Court also said in *Graham,* at 383 U.S. 19, that "the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of § 103 . . ."

If ever there were a case where the Patent Office beamed with "laxity" rather than with "intensity" on the requirements of Section 103, it is in this case. In the words of Mr. Justice Douglas, concurring in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U.S. at 156 (1950):

> "The attempts through the years to get a broader, looser conception of patents than the Constitution contemplates have been persistent. The patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents—gadgets that obviously have had no place in the constitutional scheme of advancing scientific

knowledge. A few that have reached this Court show the pressure to extend monopoly to the simplest of devices."

Following this observation the concurring opinion in the *A & P* case sets forth a list of such patented trivia as a door knob made of clay, rubber caps on pencils as erasers, etc., and following this catalogue of patented trivia the concurring opinion refers to the "incredible patents which the Patent Office has spawned." 340 U.S. at 156-158.

It is apparent from the present case that some segments of the Patent Office persist in ignoring the admonitions of this Court and continue to spawn incredible patents on trivial devices.[6] The issuance of such patents places a heavy burden upon the public and upon competitors to defend expensive and protracted patent litigation.[7] The most practical and speedy remedy for this lax practice of the Patent Office and the burden it places on the public is to apply Rule 56. Moore's Federal Practice, 2nd Ed., Vol. 6, pages 2613-2617 states the general rule, which has been universally accepted until the present case, that summary judgment is appropriate in patent cases including cases where the issue is obviousness, and that summary judgment is on no different footing in such cases than in others. The general purpose of Rule 56 is described by the same authority at Section 56.04[1], page 2057 as a "procedural device for promptly disposing of actions in which there is no genuine issue as to any material fact."

The effect of the decision of the Court of Appeals in this case is to withdraw the test of obviousness from the

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6. The Tichnor patent application was filed and prosecuted after the *Graham* decision.

7. According to Mayer, "The Lawyers", pp. 400-401, patent infringement trials are very costly. Present counsel for Petitioner aver that $25,000 is a very modest cost of trying a patent case. Additionally, Respondent has engaged and is presently engaged in a publicity campaign hailing the Court of Appeals decision as a victory. Specimens of such publicity are reproduced in Appendix IV.

reach of Rule 56 and to require trial of all patent cases where the issue is obviousness. The function of Rule 56 is, therefore, perverted.

3. The impact of *Graham* on Rule 56 was misconstrued by the Court of Appeals.

The Court of Appeals read into *Graham* a requirement that allegations of unobviousness must be tried and cannot be disposed of by a motion for summary judgment under Rule 56 supported by stipulated items of prior art. The Court of Appeals said that *Graham* ". . . increased the hazards of this [Rule 56] route to decision" and that, in addition to the general requirements of Rule 56 ". . . specific inquiries are exacted by *Graham*". 394 F.2d at 435; 157 U.S.P.Q. at 662, Appendix I at 6a, 7a.

In *Graham,* at 383 U.S. 17, this Court pointed out that the scope and content of the prior art are to be determined, differences over the prior art are to be ascertained and the level of skill is to be resolved and that such secondary considerations as commercial success, long felt but unsolved needs and failure of others might be utilized to shed light on the subject. This Court did not, however, lower the standard of invention when attacked by summary judgment under Rule 56. On the contrary, at 383 U.S. 19 this Court said:

> "We have been urged to find in § 103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. Technology, however, has advanced—and with remarkable rapidity in the last 50 years. Moreover, the ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an evenhanded application to require that those persons granted the benefit of a patent monopoly be charged with an aware-

ness of these changed conditions. The same is true of the less technical, but still useful arts. He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office."

The plain meaning of this is that the Constitutional standard of invention remains invariable. This meaning has been distorted by the Court of Appeals to mean that the standard of invention is relaxed to the vanishing point for purposes of summary judgment.

4. The decision of the Court of Appeals is in conflict with cases in the Ninth, Second and Third Circuits as to the effect of *Graham* on Rule 56 in Section 103 cases.

In *Walker v. General Motors*, 362 F.2d 56 (9th Cir. 1966) the propriety of summary judgment under Rule 56 as to obviousness was squarely raised. The Court of Appeals for the Ninth Circuit held (citing *Graham*) that summary judgment is appropriate and that, as regards the factual background needed for a judgment, "a summary judgment invariably rests on a factual foundation". 362 F.2d at 59. This rule was followed and *Walker* was cited in another Ninth Circuit case, *Alladin Plastics, Inc. v. Jerrold Stephan Co.*, 362 F.2d 532 (9th Cir. 1966).

Monoplastics, Inc. v. Caldor, Inc., 378 F.2d 20 (2nd Cir. 1967) is to the same effect.

> "Appellant suggests that the summary judgment motion should not have been granted without the taking of testimony from experts in the pertinent area of knowledge. We agree, however, with the court below that the three-piece plastic towel rack patented by Mayer when combined with integral molded-in polypropylene plastic hinges to make the Monahan one-piece plastic towel rack did not create a patentable invention for the resulting device would have been obvious to

> persons having ordinary skill in the plastics molding industry, and would even have been obvious to ordinary laymen of modest intelligence. Under these circumstances the court had no need for expert testimony in order to examine the nature of the prior art or the level of skill in the relevant industry. Therefore summary judgment was properly granted." 378 F.2d at 21.

This opinion does not refer specifically to *Graham*, but it cites *Walker, supra*, for the rule given in the excerpt above.

Allen-Bradley Co. v. Air Reduction Co., 391 F.2d 282 (3rd Cir. 1968) affirmed a summary judgment in a *per curiam* opinion. The Court of Appeals for the Third Circuit used the following language:

> "In our view, the structures involved seem so simple, the role and functions of the device and its several components so clear and normal, and the opposing contentions of the parties so understandable, that no useful function would have been served by testimony concerning obviousness by persons claiming special skill in mechanics or experience in dealing with the problems of packaging this device solved." 391 F.2d at 283.

CONCLUSION

It is respectfully submitted that the writ should issue.

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WILLIAM G. MACKAY
PAUL L. MAY

Appendix I

Opinion of the Court of Appeals

United States Court of Appeals
For the First Circuit

No. 7025.

COLOURPICTURE PUBLISHERS, INC.,
Plaintiff, Appellant,
v.
MIKE ROBERTS COLOR PRODUCTIONS, INC.
Defendant, Appellee.

Appeal from the United States District Court
for the District of Massachusetts
[272 F. Supp. 280]

Before ALDRICH, *Chief Judge,*
MCENTEE and COFFIN, *Circuit Judges.*

David Wolf, with whom *George L. Greenfield* and *Wolf, Greenfield & Hieken* were on brief, for appellant.

Melvin R. Jenney, with whom *Edward B. Gregg, Paul L. May, William G. MacKay, Gregg and Stidham*, and *Kenway, Jenney & Hildreth* were on brief, for appellee.

May 8, 1968.

COFFIN, *Circuit Judge.* Appellant, Colourpicture Publishers, Inc. (Colourpicture) sued appellee Mike Roberts Color Productions, Inc. (Roberts) for infringing its patented device of displaying a strip of connected but separable postcards hanging in a vertical row, from a hook with room for advertising at the top. After various affi-

davits and exhibits were filed, both parties moved for summary judgment. The district court, without hearing argument, granted Roberts' motion, adjudged the patent invalid, but held that if it were valid, Roberts' product infringed. Only the former ruling is at issue on this appeal. Despite the provokingly irresistible simplicity of the facts, we reverse.

Apparently from immemorable time, postcards have been sold individually or in album packets with pictures on both sides or one side, individually attached to the binder, loosely lying within, or folded together in accordion fashion. The latter mode—an album of a folded perforated postcard strip—was patented in England by one Haddan in 1904. Only in 1965 did one Tichnor, Colourpicture's assignor, file an application for a patent, received in 1966, on the idea of linking easily separable postcards in one unfolded sheet carrying an advertising panel at one end with a hole for hanging.

The advantages claimed over the prior art can be summarized as follows: for the producers, low cost manufacture; for the retailers, economic and effective display and servicing[1]; for the consumers, instant appraisal. While this alleged advance over the prior art may have fallen short in the public mind of a successful heart transplant, its effect in the market appears from the affidavits as impressive.[2] Colourpicture offered affidavits from 37 dis-

1. While not covered by either the claims or specifications, other advantages appeared when the Scenicard went on the market: reduction in soiling, manhandling, misplacing in racks, and pilferage.

2. The Scenicard zoomed Colourpicture's sales from a prior high level of $200,000 of card sales to $900,000 in the first full year in which the new product was offered. In a year and a half Colourpicture had sold the equivalent of one new card to one out of eight Americans. And all for $5,000 in advertising.

tributors of postcards, who had been in the business from one to 25 years. They acknowledged the novelty, utility and unobviousness of the Scenicard, stating that "none of the previous devices in the postcard field . . . suggest, imply, lead to, or perform the functions of the Scenicard."

Roberts, in supporting its motion for summary judgment, relied on the Tichnor file wrapper, the Haddan patent, and examples of albums of postcards either folded together or separately secured to a binder. The gist of the file wrapper proceedings is that the examiner refused a patent until Tichnor amended his claims to specify that the single sheet of cards would be "arranged substantially in a single plane" and that "substantially all of the graphic illustrations [would be] presented to the eye in their correct viewing positions. . . ." Roberts' own product, "Six-Pix", varied from Scenicard only in that two of the string of postcards are correctly viewed by turning the strip from a vertical to a horizontal position.

The district court ruled that the Tichnor patent was "invalid under the provisions of 35 U.S.C.A. sec. 103 for lack of invention over the prior art. *Graham v. John Decre Co.*, 383 U.S. 1 (1966)." 272 F. Supp. 280, 281 (D.C. Mass. 1967). It supported this conclusion by stating that there was "no invention" in using a hole to hang a piece of paper on a wall, nor any invention in having space for advertising material on a strip (citing tide tables, fire alarm listings, athletic schedules), nor any need for expert testimony to compare the various exhibits and determine "the lack of invention within the meaning of 35 U.S.C.A. sec. 103. . . ." *Id.* Finally, the court commented on the action of the Patent Office Examiner in first rejecting all of Tichnor's claims, then accepting a "very minor 'amendment'" to two claims and reversing his position without

indicating how the prior defect of "lack of invention" had been corrected. *Id.*[3]

While the district court repeatedly used the old "invention" language of *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1851), it is clear by its references both to *Graham, supra*, and to section 103 that it found the Tichnor patent invalid for obviousness. This observation is important because counsel for Roberts directed almost all of their argument to the proposition that the Tichnor contribution was "trivial", and not "patentable", which words we construe in context as not "novel". While we are not limited to the ground relied upon by the district court if it is clear that the judgment should be affirmed for other reasons, *see Walmac Co. v. Isaacs*, 220 F.2d 108 (1st Cir., 1955), we are not willing to hold as a matter of law on the record before us that the patent was invalid under section 101 or 102. We take the district court's finding as we think it clearly appears—that this idea was "obvious"—and judge it on that basis.[4]

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3. Section 103 reads as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

4. Appellee submits that an additional ground for affirmance, even though not dealt with by the district court, is the failure of the Tichnor claims, under 35 U.S.C. § 112, to point out the invention with sufficient particularity. The lanugage appellee criticizes as too "elastic and indefinite" is the amendment to the claims specifying that "substantially all of the graphic illustrations" be presented in their correct viewing positions. While "substantially" might be deemed fatally imprecise in connection with highly sophisticated processes or machinery, as in the cases relied on by appellee, we do not feel compelled so to rule here. *See Arnold Pipe Co. v. Eng'r Enterprise, Inc.*, 350 F.2d 885, 892-3 (5th Cir. 1965).

Having in mind the criteria set forth in *Graham, supra,* we are of the opinion that the district court did not address the required questions prerequisite to a finding of obviousness. The Court in *Graham* made a point of saying that the issue of non-obviousness ". . . lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill and the pertinent art resolved." 383 U.S, at 17.

Wholly apart from the possible contribution to these inquiries which testimony might have made, it is apparent that the court's conclusory comments as to "lack of invention" fell short of that "strict observance" of *Graham's* emphasis on an inquiry "beamed with greater intensity on the requirements of § 103." 383 U.S. at 18, 19. Nor do we have any inquiry into the existence of a long-felt need, the extent of efforts directed at this need, the relevance of Colourpicture's commercial success, the acceptance of the device by customers—the sub-tests, which, while secondary, might have relevance. *Graham v. John Deere Co., supra* at 17-18; Note, *Sub-Tests of "Non-obviousness"*, 112 U. Pa. L. Rev. 1169 (1964).

All that we say is that it is not impossible that Colourpicture, if allowed to proffer postcard manufacturers and distributors as witnesses, might establish that the simple ideas in the Tichnor patent were not obvious to practitioners in that occupation. It might also be relevant, in determining obviousness, to see whether and, if so, how the problem met by Tichnor's patent had been treated by others. *Boyajian v. Old Colony Envelope Co.,* 279 F.2d 572

(1st Cir. 1960); *cf. Eibel Co. v. Paper Co.*, 261 U.S. 45, 66-67 (1922), and 35 Geo. Wash. L. Rev. 720, 724 (1967).

As has been well said some time ago, "[c]ourts made up of laymen as they must be, are likely either to underrate or overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar. . . ." *Safety Car Heating Co. v. Gen. Elec. Co.*, 155 F.2d 937, 939 (2d Cir. 1946). A layman can be beguiled into finding a device "obvious" just because it appears so simple when viewed after the deed has been done.

It is wholly natural that, after the fact, we should analogize the hanging postcard strip to a fire alarm schedule or calendar or, for that matter, a Gobelin tapestry. But the more remote such prior art is from the context of the subject matter, the less persuasive it becomes on the question of obviousness. There is rarely anything really new under the sun. At some point the bringing together of knowledge or technique practiced in other fields becomes invention. *Ling-Temco-Vought, Inc. v. Kollsman Instr. Corp.*, 372 F.2d 263, 268 n. 1 (2d Cir. 1967).

This does not mean, as Roberts argues with surface plausibility, that if this case is not appropriate for summary judgment, no patent case is. For this case, at least as it is presented to us, is not one where, as in *Converse v. Polaroid Corp.*, 242 F.2d 116 (1st Cir. 1957), the issue of patentability depended wholly upon scrutiny of the prior patents. Nor is this to say that even the issue of obviousness could not in a proper case be decided by summary judgment. *See Walker v. Gen. Motors Corp.*, 362 F.2d 56 (9th Cir. 1966). But we do say that where obvious-

ness is the issue, *Graham* increased the hazards of this route to decision.[5]

In addition to the stringent requirements governing summary judgment generally and the specific inquiries exacted by *Graham*, the presumptive validity given to patent claims under 35 U.S.C. § 282 is also pertinent.[6] We conclude that the district court erred in granting summary judgment under section 103, noting, however, that nothing we have said here should be interpreted as indicative of the ultimate validity or invalidity of the Tichnor patent.

Judgment will be entered vacating the judgment of the District Court and remanding the case for further proceedings not inconsistent with this opinion.

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5. For guidance in this circuit we should note that while *Converse* on its facts still seems to us a case peculiarly appropriate for summary judgment disposition, our rule of decision is subject to qualification. We held that summary judgment was available where the " 'prior art and the patent claims are, without expert aid, easily understandable by anyone of the most modest intelligence.' [citation omitted]." 242 F.2d at 120. As to a case which can be disposed of by analysis of patent claims, the principle still holds. But to the extent that scrutiny, comparison, and evaluation of the prior art beyond that revealed in patent claims are involved, there is need for greater caution in granting summary judgment. Whether such caution would have dictated a different result in *Glagovsky v. Bowcraft Trimming Co.*, 267 F.2d 479 (1st Cir.), *cert. denied*, 361 U.S. 884 (1959), where the precise device in issue had been used in closely affiliated arts and a close approximation had been used in the same art — we need not and cannot say.

6. Roberts argues that any presumption was negatived by the failure of the patent examiner to consider such examples of prior art as certain postcard packet exhibits presented to the district court. Such examples, however, do not seem to us to illustrate any significant enlargement of the concept embodied in the Haddan patent which the examiner considered.

Appendix II

Judgment of the Court of Appeals

United States Court of Appeals for the First Circuit

No. 7025.

COLOURPICTURE PUBLISHERS, INC.,
Plaintiff, Appellant,

v.

MIKE ROBERTS COLOR PRODUCTIONS, INC.,
Defendant, Appellee.

JUDGMENT

May 8, 1968

This cause came on to be heard on appeal from the United States District Court for the District of Massachusetts, and was argued by counsel.

Upon consideration whereof, It is now here ordered, adjudged and decreed as follows: The judgment of the District Court is vacated, and the case is remanded for further proceedings not inconsistent with the opinion filed today.

By the Court:
/s/ ROGER A. STINCHFIELD
Clerk.

Appendix III

Opinion of the District Court

September 8, 1967

CAFFREY, D.J.

This is a civil action brought pursuant to the Patent Act of 1952, 35 U.S. Code, secs. 271, *et seq.* Plaintiff is a corporation organized and existing under the laws of Massachusetts, with a principal place of business in Boston. Defendant is a corporation organized and existing under the laws of California, and has a regular and established place of business and is registered to do business in Massachusetts.

Plaintiff is the owner of United States Patent No. 3,259,304 (hereinafter '304), issued July 5, 1966, on the basis of an application "POSTCARDS" filed May 25, 1965 by Lawrence F. Tichnor and assigned by Tichnor to plaintiff prior to the filing of this action. Both plaintiff and defendant are now and have been for some years engaged in the manufacture and sale of postcards.

The matter came before the Court on the basis of the defendant's motion for summary judgment which asserts that the '304 patent is invalid for lack of invention, and upon the basis of plaintiff's motion for summary judgment seeking dismissal of defendant's counterclaim.

I. *Re Defendant's Motion for Summary Judgment*

Defendant's motion is supported by the following exhibits attached thereto:

A. Copy of the '304 patent.
B. Certified copy of the file wrapper and Patent Office file contents of the '304 patent.
C. Copy of the Haddan British patent No. 9023 issued in 1904, and cited by the Patent Office Examiner on page 15 of Exhibit B.

D, E, F, G. Examples of the prior art consisting of packets and strips of picture postcards.

Defendant in its motion for summary judgment requests the Court to take judicial notice, and it does, of the fact that the packets and strips of postcards of the general character of Exhibits D, E, F and G have been sold and used for many years prior to 1965. Included in the file is a stipulation that Exhibits D, E, F and G are, in fact, samples of devices which were on sale in this country more than one year prior to the 1965 filing date of the application for the '304 patent. The stipulation also provides that a folder entitled "FOLD-A-LETTER" and marked "Defendant's Exhibit H" is a product of plaintiff which was on sale in this country for more than one year prior to the filing date of the application for the '304 patent.

On the basis of Exhilbits D, E, F, G and H, I rule that the '304 patent is invalid under the provisions of 35 U.S.C.A. sec. 103 for lack of invention over the prior art. *Graham v. John Deere Co.*, 383 U.S. 1 (1966) An examination of plaintiff's alleged invention (Pl. Ex. 2) shows that it consists of nothing more than a glossy cardboard strip divided into six colored postcards, each detachable from the remainder at its perforated edges, together with a short additional strip utilized for the purpose of hanging it on a wall through the medium of an ordinary round hole punched therein. There is no invention in using a punched hole to hang a piece of paper on a wall. The Court will judicially notice that calendars have been affixed to walls for a great many years through the medium of a punched hole in the top portion thereof. There is likewise no invention in having space for advertising material at the top or elsewhere on the strip, since it is a matter of common knowledge susceptible of judicial notice that in-

numerable calendars, and other cardboard display pieces suitable for wall hanging, such as high and low tide tables, local fire alarm listings, and athletic team schedules, to name but a few, have had advertising material imprinted on them for a great many years. No expert testimony is necessary to compare the various exhibits before the Court on this motion and to determine the lack of invention, within the meaning of 35 U.S.C.A. sec. 103, on the basis of which defendant's motion for summary judgment must be granted. *George P. Converse & Co. v. Polaroid Corp.*, 242 F.2d 116, 120 (1st Cir. 1957); *Glagovsky v. Bowcraft Trimming Co.*, 267 F.2d 479 (1st Cir. 1959).

It is not without significance that on January 24, 1966 the Patent Office acted on the Tichnor application filed May 25, 1965 and the action consisted of a denial by the Patent Office Examiner of all six claims of that application. Defendant's Exhibit B establishes that:

> "Claims 1 to 6 are rejected as unpatentable over the British patent to Haddan in view of *Kahn* under 35 U.S.C. 103. It would amount to an obvious variation to provide the British patent to Haddan with an aperture for hanging. Moreover, Kahn shows it to be old to employ such an aperture."

Thereafter, counsel for plaintiff conferred with the Patent Office Examiner and filed a very minor "amendment" to the application which consisted of certain relatively trivial changes in Claims 1 and 5 and the elimination of Claim 6. This "amendment" was accompanied by a six-page brief captioned "Remarks," which despite its semantic dexterity did not add any invention to the Tichnor application, but, nevertheless, it did succeed in persuading the Examiner to reverse his position. This he did without shedding any light on what invention was contained in the amended patent application over and above the lack of invention he found in the original application!

II. *Re Plaintiff's Motion for Summary Judgment*

Plaintiff's motion for summary judgment seeking the dismissal of defendant's counterclaim and adjudication that the '304 patent is valid and infringed is supported by:

Exhibit 1. A sample of defendant's accused device sold under the trademark "SIXPIX."

Exhibit 2. A sample of plaintiff's multipicture postcard device made under the '304 patent and sold under the trademark "SCENICARD."

Exhibit 3. A group of affidavits from customers of plaintiff.

Exhibit 4. Affidavit of Harry Tichnor.

Exhibit 5. Affidavit of Lawrence Tichnor, the original patentee of the '304 patent.

Exhibit 6. Request for Admission addressed by plaintiff to defendant.

Defendant's counterclaim seeks an adjudication (a) that the '304 patent is invalid; (b) that the '304 patent is not infringed by defendant, and (c) an injunction against plaintiff's asserting the '304 patent against defendant or any customers of defendant.

In light of the ruling on defendant's motion for summary judgment it follows that so much of plaintiff's motion for summary judgment against the counterclaim as seeks a ruling of validity of the '304 patent is denied. So much of plaintiff's motion as resists an order enjoining plaintiff from asserting validity of the '304 patent against defendant or its customers is denied. However, in view of the nature of the products manufactured and sold by the parties, expert testimony is no more necessary to make a determination of infringement than to make a determina-

tion of invalidity for lack of invention. *George P. Converse & Co. v. Polaroid Corp., supra.* On the basis of the exhibits before the Court on these cross-motions, particularly plaintiff's Exhibits 1 and 2, samples of the competing products of the parties, I rule that were the '304 patent valid then it would be infringed by defendant's "SIXPIX." Because the patent is invalid, defendant's motion for summary judgment is allowed, the complaint is dismissed, and a decree granting defendant the injunctive relief requested will be entered.

Judgment accordingly.

(s) ANDREW A. CAFFREY
U.S. District Judge

Appendix IV

Publicity Concerning the Court of Appeals Decision Promulgated by Respondent

News Release by Respondent

Mike Roberts Infringes Colourpicture Patent

In a patent suit against Mike Roberts Color Productions, Inc., Berkeley, Calif., the United States Court of Appeals for the First Circuit has reversed a lower court finding that Colourpicture Publishers' patent on its Scenicard was invalid. The Appeals Court, however, let stand the lower court finding that Mike Roberts' SixPix infringed the Scenicard patent. The Appeals Court also awarded Colourpicture costs in connection with the appeal and remanded the case to the lower court with instructions for further proceedings not inconsistent with its opinion.

In finding for Colourpicture, Circuit Judge Coffin said that "The Scenicard zoomed Colourpicture sales. . . ." and that the Scenicard advantages included low cost manufacture for the producers; reduction in soiling, misplacing in racks and pilferage as well as economic, effective display and servicing for the retailers; and instant appraisal for the consumer.

Judge Coffin said that the "presumptive validity" of the Colourpicture patent claims under the patent law was "also pertinent". Anyone who sells articles infringing a valid patent is liable to the patent owner for damages, interest and costs. The trial court may also treble damages and award attorney fees against the seller.

Publicity in Souvenirs & Novelties, June-July, 1968

APPEALS COURT REVERSES IN SCENICARD PATENT SUIT

In a patent suit against Mike Roberts Color Productions, Inc., the U.S. Court of Appeals, first circuit, reversed a

lower court finding that Boston, Mass. Colourpicture Publishers' patent on its Scenicards was invalid. Scenicards are a strip of connected but separable postcards hanging in a vertical row, from a hook with room for advertising at top.

The appeals court found the lower court erred in using obviousness to invalidate the patent, when the lower court did not make the factual inquiries to determine obviousness. The court also noted, "the Scenicard zoomed Colourpicture sales from a prior high level of $200,000 of card sales to $900,000 in the first full year in which the new product was offered . . . And all for $5,000 in advertising."

Circuit Judge Coffin said that the Scenicard advantages included low cost manufacture for the producers; reduction in soiling, misplacing in racks and pilferage as well as economic, effective display and servicing for the retailers; and instant appraisal for the customer."

As the case stands now, the Colourpicture patent is valid. The lower court said Mike Roberts' Six Pix infringed the patent, if the patent is valid.

The validity of the patent has not yet been finally decided in a trial court. The case goes back to a lower court.

Mike Roberts Color Productions had no comment to make on the case, when queried by Souvenirs & Novelties Magazine in their Berkeley, Calif. offices. Nor did their Boston attorneys when also queried.

Publicity in Amusement Business, July 13, 1968

APPEAL GOES TO COLOURPICTURE

The U.S. Court of Appeals for the First Circuit, Berkeley, Calif., [sic] has reversed a lower court finding that Colourpicture Publishers' patent on its Scenicard was invalid in a patent suit against Mike Roberts Color Produc-

tions, Inc. The Appeals Court also let stand the lower court finding that Mike Roberts' SixPix infringed the Scenicard patent.

Colourpicture was awarded costs in connection with the appeal and the case was remanded to the lower court with instructions for further proceedings not inconsistent with the Appeals Court's opinion.